

#### REMARKS

The present Amendment responds to the Office Action mailed on January 22, 2004. Since this response is not filed within the shortened statutory period of three months, it is accompanied by a Petition for Enlargement of Time pursuant to 37 CFR § 1.136(a) and accompanied by the fee set forth 37 CFR § 1.17(a). This Office Action rejected 19 pending claims based Section 103 of the Statute. All claims have been amended, except for claim 20 which has been withdrawn by the Examiner on grounds of being directed to a non-elected species. Re-consideration and re-examination of the application has herewith amended is respectfully requested.

Prior art rejections have all been based on the new reference Kagami(JP 6-171650), in combination with other references. An appropriate amendment has been made to claim 3 in accordance with the requirements of the Examiner. The same correction is voluntarily made to claim 16.

Claims 1-3, 5-6, 9-10, 12 and 16 were rejected on Kagami in view of Bozlee. Bozlee is a reference from a totally unrelated field of art, and thus is a nonanalogous reference. Bozlee is directed to placing a sticky label around a handle of a shopping bag. It is not in any manner a protective member. It would not be obvious to one even skilled in the art to take the indicia properties of Bozlee directed to a handle and apply that sale of information to the sale of information on a consumer removed flexible protective member adhered to sealed beverage containers where the protective member forms a substantially wrinkle free skin tight seal. There is no suggestion to look in the handle art as it

would not solve any of the other concerns addressed by the business method of the claimed invention. There is also no suggestion in either of these references to combine them in any way.

Most claims have also been provisionally rejected under the nonstatutory double patenting rejection that has been judicially created. When and if claims are allowed in the copending Application Number 10/360,488, a terminal disclaimer will be provided as instructed by the Examiner.

The principal amendment to the claims have been made to claims 1, 16 and 17. It arises from the recognition that none of the claims that have been presented in this application has explicitly recognized that the business method that is the subject of the present application relates to a new business entity that is certainly not recognized in Kagami and probably not in any of the other references cited by the Examiner either. Arguments have been previously made by Applicant that the business method of the present invention has created a new business and new source of revenue. What has been omitted from the claims previously presented and the arguments is that this method creates a new business party, not just a new business. The new business party is the protective member manufacturer who has created this new business. Kagami, and so far as can be recalled, all of the other references cited by the Examiner, do not recognize that there is a new party created by the business method. That is, instead of the container filler and the consumer, and in a few references including Kagami, an advertiser (referred to in Kagami as a "sponsor"), there is in this invention a fourth party referred to

as the "protective member manufacturer." It is the protective member manufacturer who sells, for profit, to third party advertisers a right to attach indicia to protective members which are adhered to the beverage container, probably by the container filler, and sold to consumers for consumer removal of the protective member. None of the prior art references teach the existence of the fourth party who is the one who makes a living, a profit, from the advertising that others have recognized including Kagami. Furthermore, it is of note that Kagami does not teach making a living or a profit from the advertising. Kagami recites that

beverage manufacturers can enjoy the benefits of customer attraction by means of sanitary cover seal while covering the cost of the sanitary cover seal with the advertising revenue; and sponsors can implement highly effective advertising with a novel method, and these benefits for the three parties lead to high economical effects.

It is very clear that Kagami does not recognize the use of this technique as a profit making venture for anyone except for the financial benefit that the "sponsor" would enjoy from increased sales of its product. In the present invention the motive is entirely different. It is the making of a profit by a fourth party from the third party paid advertising applied by the container filler and consumed by the public.

Applicant notes that the previous amendment to the claims providing for a substantially wrinkle free seal between the protective member and at least a portion of the mouth contact area of the containers is the subject of a rejection based on Kagami. The rejection of this feature is respectfully traversed. Kagami is

silent on the subject of a substantially wrinkle free seal, there being no such assertion in the text of the translation. The Examiner cannot read that limitation into Kagami by looking at one drawing, figure 3. The other drawing referenced by the Examiner, figure 4, is a cross section that cannot teach anything about something being wrinkle free.

Either of these two features of the independent claims should be sufficient to render them allowable, but especially the first change recognizing that there are four parties rather than three and that the fourth party is the one that has established a new business method for making a profit from advertisers at new situs.

Although Applicant believes that all the presently pending claims are now in condition to allowance, undersigned counsel remains available for a telephone interview if doing so will facilitate the resolution of any remaining technicalities such as may be the proper subject of an Examiner's Amendment with the concurrence of undersigned counsel. In the event that such an interview would be of use, the Examiner has respectfully invited the telephone undersigned counsel at the telephone number listed below.

Finally, the Examiner is again invited to note that the address of undersigned counsel has changed and to use the address listed below in the future.

#### CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing paper has been deposited this 24th day of May, 2004 with the United States Postal Service

with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 which is a date prior to the expiration of the set period, as extended if necessary, and I therefore assert timely filing of the foregoing paper in accordance with 37 CFR § 1.8. Applicant notes that a Petition for Enlargement of Time pursuant to 37 CFR § 1.136(a) and accompanied by the fee set forth 37 CFR § 1.17(a) is enclosed, extending the time to May 22, 2004, which fell on a Saturday, further extending the time to May 24, 2004.

Respectfully submitted,

ROBERT J. VAN DER WALL, P.A.  
1200 Brickell Avenue  
Suite 1620  
Miami, FL 33131  
Telephone: (305) 358-6000  
Facsimile: (305) 530-8880

By: 

ROBERT J. VAN DER WALL  
Attorney for Applicant  
Registration No. 28,125